

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 9, 15, 20, 26 and 32 are currently being amended.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 9-33 remain pending in this application.

Summary of Rejections:

Claims 9-33 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter.

Claims 9-19, 23-24 and 26-33 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent Publication No. 2003/0156640 to Sullivan in view of U.S. Patent No. 5,680,483 to Tranchard.

Claims 20-22 and 25 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Sullivan.

Discussion of Rejections under 35 U.S.C. § 101:

Claims 9-33 were rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Applicant respectfully disagrees with the Examiner's position and, therefore, traverses these rejections for at least the following reasons.

In rejecting these claims, the Examiner is asserting that the pending claims are not tied to a particular device to carry out the recited process and are, therefore, directed to non-statutory subject matter under 35 U.S.C. § 101. See Office Action, dated July 6, 2009, page 2, lines 10-12. However, in the same Office Action, the Examiner is arguing that, based on the recent Supreme Court and Federal Circuit Court decisions, a statutory process under 35 U.S.C. § 101 must be either (1) tied to another statutory category, or (2) transform underlying subject matter to a different state or thing. See Office Action, dated July 6, 2009, page 2, lines 17-20. Applicant respectfully notes that the Examiner has failed to consider Applicant's previous claim amendments in response to the Office Action, dated December 16, 2008. Applicant hereby incorporates by reference the arguments made in response to the Office Action, dated December 16, 2008, in their entirety.

In response to the Office Action dated December 16, 2008, Applicant had amended the pending claims to recite either encoding material into a bitstream or decoding material from a bitstream. Applicant had further argued that the above-noted amendments clearly meet the second prong of the "machine-or-transformation test" by transforming the information into a bitstream. In response, the Examiner has merely responded that these amendments do not overcome the rejections because they fail to tie the claimed features to a particular device or apparatus. See Office Action, dated July 6, 2009, page 2, lines 10-12. However, the Examiner has failed to indicate if, and why, the claim amendments do or do not satisfy the second prong of the "machine-or-transformation test," namely transforming the underlying subject matter to a different state or thing.

Nevertheless, in order to expedite the prosecution of the present application, Applicant has amended claims 9, 15, 20, 26 and 32 to recite that the features of the pending claims are carried out by either a video encoder or a video decoder. Support for the amended features of claims 9, 15, 20, 26 and 32 may be found in the originally filed specification and drawings at, for example, the Abstract and page 16, lines 9-20. As such, amended claims 9, 15, 20, 26 and 32 recite a particular device or apparatus. Accordingly, independent claims 9, 15, 20, 26 and 32, as well as the corresponding dependent claims, are directed to statutory subject matter under 35 U.S.C. § 101. Therefore, Applicant respectfully requests that the rejection of claims 9-33 under 35 U.S.C. § 101 be withdrawn.

Discussion of Rejections under 35 U.S.C. § 103(a):

Claims 9-19, 23-24 and 26-33 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sullivan in view of Tranchard. Applicant respectfully disagrees with the Examiner's position and, therefore, traverses these rejections for at least the following reasons.

In rejecting claim 15, the Examiner has referenced Figures 1-3 and paragraphs [0010], [0011], [0016] and [0026] of Sullivan. Figures 1 and 2 of Sullivan, and the relevant section of Sullivan's disclosure, describe a sequence of pictures that are ordered and indexed from left to right, starting with an I-picture 100 (I0), in the order in which the pictures will be displayed. The pictures subsequent to the I-picture (I0) are B1, B2, P3, B4, B5, P6, B7, B8, I9, B10, B11, ... in the display order. Figure 3 of Sullivan depicts a slightly different sequence of pictures in the following order: I0, P3, B1, B2, P6, B4, B5, I9, B7, B8, P12, B10, B11, ... These picture are arranged in the transmission order (and in the encoding order), while maintaining their original numbering scheme that indicates the display order (and the decoding order) of the picture frames. It can be seen from Figure 3 of Sullivan that pictures B7 and B8 are transmitted after the picture I9. However, the numbers associated with these picture frames indicate that these pictures are displayed in the order B7, B8, and I9. As evident from Sullivan's Figure 1, pictures B7 and B8 are predicted on the basis of pictures P6 and I9. Sullivan, in paragraph [0021], further describes a "closed GOP flag" that may be provided for individual I-pictures to indicate whether any subsequent picture in the transmission order (after the I-picture) refer to a picture previous to that I-picture.

These, and other, sections of Sullivan, however, fail to teach or suggest the various features that are recited in pending claim 15. In particular, claim 15 recites:

"a first indication indicating whether or not at least a part of at least one picture is encoded with reference to a picture preceding the intra coded picture in encoding order, the at least one picture having an encoding order succeeding the intra coded picture; and performing motion compensated prediction for a second picture with reference to the at least one picture" (emphasis added).

Comparing the features of claim 15 and the description of Sullivan reveals that, while pictures B7 and B8 of Sullivan (that are predicted from picture I9) succeed I9 in the encoding order, these pictures (B7 and B8) are not used for predicting other pictures in the sequence. As such, Sullivan's disclosure fails to teach or suggest at least "performing motion compensated prediction for a second picture with reference to the at least one picture," which is recited in Applicant's claim 15.

Further, Sullivan's "closed GOP flag" (described in paragraph [0021] of Sullivan) cannot be construed as teaching or suggesting the features of the pending claims since this flag only pertains to the I-pictures, and it merely indicates whether or not a group of pictures (GOP) is closed (depending on whether the B-pictures that immediately follow each of those I-pictures in decoding order use prediction from the picture previous to the I-picture). Sullivan's closed GOP flag does not indicate that "at least a part of at least one picture is encoded with reference to a picture preceding the intra coded picture in encoding order, the at least one picture having an encoding order succeeding the intra coded picture," as is recited in pending claim 15.

Further, Tranchard fails to cure the above-noted deficiencies of Sullivan. Applicant respectfully directs the Examiner's attention to the previous arguments regarding the inapplicability of Tranchard to the pending claims set forth in response to the Office Action, dated December 16, 2008.

Accordingly, claim 15 is patentable.

Independent claims 9, 26 and 32 recite features that are similar to those discussed above in connection with claim 15. Accordingly, claims 9, 26 and 32 are patentable for similar reasons as claim 15.

As to claims 10-14, 16-19, 23-24, 26-31 and 33, these claims each depend, either directly or indirectly, from one of allowable claims 9, 15, 26 or 32 and are, therefore, patentable for at least that reason, as well as for other patentable features when these claims are considered as a whole.

Discussion of Rejections under 35 U.S.C. § 102(e):

Claims 20-22 and 25 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Sullivan. Applicant respectfully disagrees with the Examiner's position and, therefore, traverses these rejections for at least the reasons that follow.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. M.P.E.P. § 2131. The identical invention must be shown in as complete detail as is contained in the claim. *Id.*

In the present case, independent claim 20 recites features that cannot be found, either expressly or inherently, in the disclosure of Sullivan.

The Examiner is arguing that Sullivan, in Figures 1 to 3, and in paragraphs [0011], [0021] and [0078] to [0084], describes the features that are recited in pending claim 20. See Office Action, dated July 6, 2009, page 7, lines 14-23. Applicant respectfully disagrees. The above-noted sections of the Sullivan describe numerous aspects of Sullivan's invention. However, the Examiner has failed to indicate which particular feature of Sullivan's disclosure allegedly anticipates specific features of pending claim 20. For example, paragraph [0011] of Sullivan describes the conventional pictures frames and Group of Frames (GOP) of MPEG video encoding, paragraph [0021] of Sullivan describes the "closed GOP flag" that was discussed above in connection with the rejection of the pending claims under 35 U.S.C. § 103(a), paragraph [0078] of Sullivan relates to the so-called "Best Effort Decoding," paragraph [0080] of Sullivan relates to the so-called "Assured Decoding," and paragraphs [0082] to [0084] of Sullivan describe step-wise processes for carrying out the Best Effort Decoding and Assured decoding operations. While these sections relate to many different (or alternate) aspects of Sullivan's disclosure, the Examiner has referenced all of these sections as the basis for rejecting the first feature of pending claim 20. Applicant is, therefore, unable to ascertain which aspect of Sullivan's disclosure is being asserted by the Examiner against the pending features of claim 20. As such, Applicant respectfully requests

that the Examiner either withdraw this rejection or state, with particularity, the specific features of Sullivan's disclosure that allegedly anticipates the features of the pending claims.

Nevertheless, after careful review of all the referenced sections of Sullivan, Applicant has not been able to find any teachings or suggestions that describe at least "retrieving... a first indication corresponding to an intra-coded picture, the first indication indicating that all decoded coded pictures at and subsequent to the intra-coded picture in display order can be correctly decoded when a decoding process is started from the intra-coded picture," which is recited in pending claim 20. For example, the "closed GOP flag," that is described in paragraph [0021] of Sullivan, indicates whether any subsequent pictures in the transmission order (after the I-picture) refer to a previous I-picture. As such, Sullivan's "closed GOP flag" can be distinguished from the "first indication" at least based on the fact that the former relates to subsequent pictures in transmission order, whereas the latter relates to coded pictures in the display order. Similarly, other sections of Sullivan fail to teach or suggest the above-noted features of claim 20. Accordingly, claim 20 is patentable.

As to claims 21, 22 and 25, these claims depend, either directly or indirectly, from allowable claim 20, and are, therefore, patentable for at least that reason, as well as for other patentable features when these claims are considered as a whole.

Conclusion:

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid

amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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